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In re Application of	:
John G. Bauman et al	:
Serial No.: 10/782,024	: PETITION DECISION
Filed: February 18, 2004	:
Attorney Docket No.: 140140.401	:

This is in response to the petition under 37 CFR 1.144, filed March 16, 2005, requesting withdrawal of an improper restriction requirement.

#### BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on February 18, 2004, and contained claims 1-17. In a first Office action, mailed August 25, 2004, the examiner required restriction between the inventions claimed, as follows:

- Group I – Claims 1-5 drawn to Lipoxin A4 analogs;
- Group II – Claims 6-7, 10-12 and 15-17 drawn methods of treating inflammatory or autoimmune disorders with the compounds of claim 1; and
- Group III – Claims 8-9 and 13-14 drawn to a method of treating pulmonary or respiratory tract inflammation using the compounds of claim 1.

An election of species was also required for whichever group was elected.

The examiner reasoned that the compounds and methods of use were separate and distinct inventions based on use of the product in other materially different methods.

Applicants replied on September 27, 2004, electing the compounds of Group I with traverse. Applicants argued that the examiner has failed to establish a separate classification for the groups, a separate status in the art or different fields of search. Applicants also elected a species, as required.

The examiner mailed a new Office action to applicants on December 16, 2004, acknowledging the election of Group I and the species, but maintaining the requirement and making it Final.

However, the examiner also indicated that the claims would be rejoined. Claims 1-2 and 6-17 were then rejected under 35 U.S.C. 102(b) as anticipated by Serban. Claims 3-5 were withdrawn as being directed to a non-elected species.

This petition was filed on March 16, 2005, and traverses the finality of the restriction requirement as in error. Applicants appear have concurrently replied to the Office action as of the date of this decision.

## DISCUSSION

The review of the prosecution history is somewhat confusing. In the initial restriction requirement between process and product claims the examiner should have included a form paragraph on rejoinder if product claims were elected for prosecution. This appears to have been an oversight by the examiner since in response to the traversal of the restriction requirement the examiner rejoined all of the method claims with the product claims.

Applicants' petition appears to be directed to only those claims which were then withdrawn, claims 3-5, directed to subgenus claims or individual species. In response to the requirement to elect a species applicants elected a species encompassed by claims 3 and 4 and specifically claimed in claim 5. Thus withdrawal of these claims in view of the species elected was in error and they will be examined with product claims 1-2.

## DECISION

The petition is **GRANTED**. The withdrawal of claims 3-5 as directed to non-elected species is withdrawn.

**No petition fee is required for this petition and the petition fee paid of \$130.00 will be credited to applicants Deposit Account No. 19-1090, as directed.**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.



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Director, Technology Center 1600